

PA4



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,295	10/08/1999	AMIR BEN-EFRAIM	M-7844US	4625

32794 7590 08/27/2003

KOESTNER BERTANI LLP  
18662 MACARTHUR BLVD  
SUITE 400  
IRVINE, CA 92612

EXAMINER
----------

DINH, KHANH Q

ART UNIT	PAPER NUMBER
----------	--------------

2155

8

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRQ

# Office Action Summary

Applicati n N .

09/415,295

Applicant(s)

BEN-EFRAIM ET AL.

Examiner

Khanh Dinh

Art Unit

2155

-- The MAILING DATE of this communication appears n th c ver sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 45-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 and 86-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-93 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

### DETAILED ACTION

1. Claims 1-93 are presented for examination.

#### Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-44 and 86-93, drawn to a mobile information network browser device with audio feedback capability, classified in class 709, subclass 225.
  - II. Claims 45-85, drawn to a method of browsing an information network via a wireless communication network and receive responsive information in audio format using a mobile audio device using a wireless communication network, classified in class 709, subclass 229.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as to a mobile information network browser device with audio feedback capability, classified in a *different Class/Subclass*. Invention II has separate utility such as a method of browsing an information network via a wireless communication network and receive responsive information in audio format using a mobile audio device using a wireless communication network, classified in a *different Class/Subclass*

1. The inventions are distinct, each from the other, because of the following reasons:

(a) These inventions have acquired a separate status in the art as shown by their different classifications.

(b) The search required for each Group is different and not co-extensive for examination purposes.

For example, the searches for the three inventions would not be co-extensive because these Groups would require different searches on PTO's classification class and subclass as following:

the Group I search (claims 1-44 and 86-93) would require use of search class 709, subclass 225 (not require for the inventions II).

the Group II search (claims 45-85) would require use of search class 709, subclass 229 (not require for the inventions I, III).

For the reasons given above restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Mary Jo Bertani (Attorney for Applicant) on 8/21/2003 a provisional election was made with traverse to prosecute the invention of a mobile information network browser device with audio feedback capability, claims **1-44 and 86-93**. Affirmation of this election must be made by applicant in replying to this Office action. Claims **45-85** are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4, 9-13, 18-26, 33, 36 and 90-93 are rejected under 35 U.S.C. 102(e) as being anticipated by Madan et al US pat. No.6,581,035.

As to claim 1, Madan discloses a mobile information network browser device with audio feedback capability, the information network comprising a plurality of network servers, the browser device comprising:

a wireless communication interface (104 fig.1) operable to transmit data to a network server (101 fig.1) and to receive data from the network server (see abstract, fig.1, col.3 lines 13-51 and col.4 lines 13-55).

an audio interface (using audio input 138 fig.1) operable to receive data from the wireless communication interface, wherein the data transmitted to the network server includes a request for information, and the data

received from the network server includes information responsive to the request (see also fig.2, col.4 line 56 to col.5 line 67 and col.7 lines 1-50).

As to claims 2 and 3, Madan discloses a voice interaction system (voice transaction message to process data transactions over the cell phone in plurality of predetermined formats) le to recognize commands from a user's speech input for interaction with the browser device including the request for information and a mobile audio device having an audio converter, the audio converter being operable to receive the information responsive to the request, the audio converter being further operable to convert the responsive information to an audio signal for output to an audio output device (see figs.2-6, col.4 line 56 to col.5 line 67).

As to claim 4, Madan does not specifically disclose at least one audio speaker (140 fig.1).

As to claim 9-13, Madan discloses a data storage medium (134 fig.1), a microphone (138 fig.1) for receiving the speech input from the user, converting the responsive information from a text format to an audio format changing a plurality of predetermined formats into the voice transaction using a Microbrowser), the first program instructions are loaded and executed in the network server and the audio interface (see figs.2-4, col.4 line 56 to col.5 line 67 and col.6 line 55 to col.7 line 50).

As to claims 18-22, Madan discloses allowing the user to enter personal information to customize interaction with the browser device (entering stock purchase information), an input buffer for storing the responsive information until the user commands the browser device to playback the responsive information and an input

buffer for storing the responsive information until the audio converter processes it (see col.5 line 6 to col.6 line 65 and col.7 line 36 to col.8 line 57).

As to claim 23, Madan discloses a position-keeping system for providing the location of the mobile audio device to the network server via the wireless communication network, wherein the responsive information is based on the location of the mobile audio device (see col.8 line 9 to col.9 line 63).

As to claim 24, Madan discloses a portable browser system with feedback capability for browsing an information network comprising:

a wireless communication network and at least one data processor in communication with the wireless communication network, the at least one data processor being operable to execute first program instructions for receiving a user's input (104 fig.1), second program instructions for requesting information from the information network (see abstract, fig.1, col.3 lines 13-51 and col.4 lines 13-55).

third program instructions for receiving responsive information from the information network, and fourth program instructions for transmitting the responsive information received from the information network (see col.5 line 1 to col.6 line 54).

an audio output device (138 fig.1) operable to receive the responsive information from the data processor, the audio output device being further operable to output the responsive information to the user in audio format (converting voice message into a recognized message or format, see also fig.2, col.4 line 56 to col.5 line 67 and col.7 lines 1-50).

Claims 25 and 26 are rejected for the same reasons set forth in claims 2 and 3 respectively.

As to claims 33 and 36, Madan discloses a telephone in communication with the voice interaction system for receiving the user's speech input and instructions are loaded and executed in the data processor (see figs.1, 2, col.4 line 21-63 and col.5 line 6 to col.6 line 65).

As to claim 90, Madan disclose a mobile information network browser device with audio feedback capability, the information network comprising a plurality of network servers, the browser device comprising:

a communication interface operable to receive data from at least one of the network servers (see abstract, fig.1, col.3 lines 13-51 and col.4 lines 13-55).

a mobile audio device (104 fig.1) operable to receive the data from the communication interface, the mobile audio device being further operable to convert the data to an audio signal to a telephone (converting voice message into a recognized message or format, see also fig.2, col.4 line 56 to col.5 line 67 and col.7 lines 1-50).

As to claims 91-93, Madan discloses mobile audio device is controlled with voice commands, control switches and is operable to receive the data from a wireless communication network (see fig.3, col.5 line 6 to col.6 line 65 and col.7 line 26 to col.8 line 57).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 5-8, 27-32, 34, 35, 37, 42-44 and 86-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madan et al US pat. No.6,581,035.

As to claims 5-8, Madan does not specifically disclose a set of headphones, broadcasting the audio signal to a channel on a car radio, a car radio and a cassette adapter. However, an Official Notice is taken that the use of those devices is generally well known in the art. It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement those well known devices into the computer system of Madan to process data transaction over the network because it would have provide more utilizations of the computer system in the network.

Claims 27-31 are rejected for the same reasons set forth in claims 4, 8, 9, 5 and 6 respectively.

Claims 32, 34, 35, 37, 42-44 are rejected for the same reasons set forth in claims 10, 11, 12, 18, 23, 21 and 22 respectively.

As to claim 86, Madan disclose a mobile information network browser device with audio feedback capability, the information network comprising a plurality of network servers, the browser device comprising:

a communication interface operable to receive data from at least one of the network servers (see abstract, fig.1, col.3 lines 13-51 and col.4 lines 13-55).

a mobile audio device (104 fig.1) operable to receive the data from the communication interface, the mobile audio device being further operable to convert the data to an audio signal (converting voice message into a recognized message or format, see also fig.2, col.4 line 56 to col.5 line 67 and col.7 lines 1-50). Madan does not specifically disclose outputting data to a car radio. However, an Official Notice is taken that the uses of those devices are generally well known in the art. It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement those well known devices into the computer system of Madan to process data transaction over the network because it would have provide more utilizations of the computer system in the network.

As to claims 87-89, Madan discloses mobile audio device is controlled with voice commands, control switches and is operable to receive the data from a wireless communication network (see fig.3, col.5 line 6 to col.6 line 65 and col.7 line 26 to col.8 line 57).

8. Claims 14-17 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madan et al US pat. No.6,581,035 in view of Logan et al., US pat. No.5,732,216.

As to claims 14-17, Madan does not specifically disclose using encrypting/ decrypting data information, and compressing/de compressing data information. However, those teachings are generally well known in the art as disclosed by Logan (see fig.1, col.3 line 23 to col.4 line 37, col.5 line 7 to col.6 line 35 and col.10 line 39 to col.11 line 67). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize Logan's teachings into the computer system of Madan to process data information because it would have enabled users to distribute, collect and exchange information in the forms of data recordings in the computer network (see Logan's col.1 lines 29-65 and col.3 lines 23-54).

Claims 38-41 are rejected for the same reasons set forth in claims 14-17 respectively.

***Other prior art cited***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Gudjonsson et al, US pat. No.6,564,261.
  - b. King, US pat. No.6,532,446.
  - c. Sora, US pat. No.6,424,945.
  - d. Hitchings Jr., US pat. No.6,594,484.

***Conclusion***

10. Claims 1-44 and 86-93 are rejected.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam Hosain, can be reached on (703) 308-6662. The fax phone numbers for this group are:

After Final: (703) 746-7238

Official: (703) 746-7239

Non-Official/ Draft: (703) 746-7240

*A shortened statutory period for reply is set to expire THREE months from the mailing date of this communication. Failure to respond within the period for response will cause the application to become*

Application/Control Number: 09/415,295


Page 10

Art Unit: 2155

*abandoned (35 U. S. C. Sect. 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(A).*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

Khanh Dinh  
Patent Examiner  
Art Unit 215 5  
8/22/2003

  
HOSAIN T. ALAM  
PRIMARY EXAMINER